

AMENDMENT UNDER 37 C.F.R. § 1.111  
U.S. APPLN. NO. 09/855,502  
ATTORNEY DOCKET NO. Q64471

**REMARKS**

Applicants thank the Examiner for acknowledging Applicants' claim to foreign priority, and for indicating that the certified copy of the priority document, French Patent Application No. 0006356 dated May 18, 2000, has been made of record in the file.

Claims 1-13 have been examined on their merits.

Applicants herein cancel claim 12 without prejudice and/or disclaimer.

Applicants herein editorially amend claims 2, 7 and 12 for reasons of precision of language. The amendments to claims 2, 7 and 12 were made merely to more accurately claim the present invention and do not narrow the literal scope of the claims. The amendments to claims 2, 7 and 12 were not made for reasons of patentability, as will be discussed below.

Applicants herein add new claims 14-16. Support for new claims 13-16 can be found, for example, on page 4, lines 22-26 of the instant specification. Entry and consideration of the new claims is respectfully requested.

Claims 1-11 and 13-16 are all the claims presently pending in the application.

1. Claims 1-13 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Berry (U.S. Patent No. 6,256,030) in view of Flinchem et al. (U.S. Patent No. 6,307,548). The rejection of claim 12 is now moot due to its cancellation. Applicants respectfully traverse the rejection of claims 1-11 and 13, and insofar as the rejection applies to new claims 14-16, at least for the reasons set forth below.

The initial burden of establishing that a claimed invention is *prima facie* obvious rests on the

USPTO. *In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984). To make its *prima facie* case of obviousness, the USPTO must satisfy three requirements:

1. The prior art relied upon, coupled with the knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated to artisan to modify a reference or to combine references. *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988).
2. The proposed modification of the prior art must have had a reasonable expectation of success, and that determined from the vantage point of the artisan at the time the invention was made. *Amgen, Inc. v. Chugai Pharm. Co.*, 927 F.2d 1200, 1209 (Fed. Cir. 1991).
3. The prior art reference or combination of references must teach or suggest all the limitations of the claims. *In re Vaeck*, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991); *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970).

The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, the nature of a problem to be solved. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). Alternatively, the motivation may be implicit from the prior art as a whole, rather than expressly stated. *Id.* Regardless if the USPTO relies on an express or an implicit showing of motivation, the USPTO is obligated to provide particular findings related to its conclusion, and those findings must be clear and particular. *Id.* A broad conclusionary statement, standing alone without support, is not “evidence.” *Id.*; *see also, In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001).

In addition, a rejection cannot be predicated on the mere identification of individual components of claimed limitations. *In re Kotzab*, 217 F.3d 1365, 1371 (Fed. Cir. 2000). Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed. *Id.*

Berry et al. disclose, *inter alia*, a method for using the keyboard of a computing device to navigate from object to object on a graphical user interface. The navigation is done using the arrow or tab keys, and the navigation may occur between objects on the same level or between objects on different levels. *See* col. 8, lines 60-65; col. 9, lines 21-35. Figures 3, 8A, 8B, 10A and 10B of Berry et al. illustrate the use of pushbutton, radio buttons and other known graphical elements. *See* col. 6, lines 54-59; col. 12, lines 37-45; col. 13, lines 1-5 of Berry et al. The tree structure as disclosed in the present invention is not depicted in these Figures.

The Examiner acknowledges that Berry et al. do not disclose the association between key lists and each object. *See* April 9, 2003 Office Action, pg. 2. The Examiner argues, however, that Flinchem et al. supply the necessary disclosure to overcome the acknowledged deficiencies of Berry et al.

With respect to claim 1, the combination of Berry et al. and Flinchem et al. fails to teach or suggest the inheritance of key lists between child graphical elements and their respective parent graphical elements. The combination of Berry et al. and Flinchem et al. has no teaching whatsoever with respect to key lists being associated with graphical elements, and inheriting key lists between parent and child graphical elements, as recited in claim 1. The Examiner argues that Flinchem et

al. allegedly teaches inheritance in Figure 10, but the Examiner's argument is not well taken. All that Figure 10 of Flinchem et al. discloses is a vocabulary tree module that is traversed based on a keystroke sequence and the data fetched thereby. *See* col. 12, lines 62-66 of Flinchem et al. The Examiner has failed to point to any teaching of inheritance in Berry et al. Therefore, assuming *arguendo* that the nodes in the vocabulary tree module of Flinchem et al. could somehow be construed as graphical elements, there is no teaching or suggestion in the combination of Berry et al. and Flinchem et al. that each element has an associated key list. Furthermore, based on the foregoing assumption that the nodes in the vocabulary tree module of Flinchem et al. could somehow be construed as graphical elements, there is no teaching or suggestion that a key list at a child graphical element inherits the key list of its corresponding parent graphical element. Therefore, Applicants believe that the Examiner has not met the "all limitations" prong of a prima facie case of obviousness, as required by *In re Vaeck*.

Applicants further believe that one of ordinary skill in the art would not have been motivated to combine Berry et al. with Flinchem et al. The Examiner asserts that one would have been motivated by the alleged key list – function association disclosed by Flinchem et al. However, claim 1 recites that child graphical elements inherit the key lists associated with their parent graphical elements. While the Examiner claims Flinchem et al. discloses inheritance, in reality all the Flinchem et al. disclose is traversing a vocabulary tree based on input keystrokes. Since Flinchem et al. lacks any teaching with respect to inheritance of key lists between child and parent graphical elements, Applicants submit that one of ordinary skill would not have been motivated to combine Berry et al. with Flinchem et al. In addition, *In re Dembiczak* and *In re Zurko* require particularized

findings regarding motivation, and the Examiner has not provided any findings with respect to inheritance. Therefore, Applicants believe that the Examiner has not met the motivation prong of a *prima facie* case of obviousness as well.

Thus, Applicants believe that claim 1 is allowable over the combination of Berry et al. and Flinchem et al. at least for the reasons set forth above, and further believe that claims 2-5 and new claim 14 are allowable as well, at least by virtue of their dependency from claim 1.

Claim 6 has similar recitations as claim 1. Applicants believe that claim 6 is allowable over the combination of Berry et al. and Flinchem et al. for the same reasons as claim 1, namely the lack of disclosure with respect to key list inheritance between child graphical elements and parent graphical elements. For the sake of brevity, Applicants incorporate by reference the claim 1 arguments concerning the “all limitations” and motivation prongs of a *prima facie* case of obviousness as applying to claim 6 as well. Applicants further believe that claims 7-10 and new claim 15 are allowable as well, at least by virtue of their dependency from claim 6.

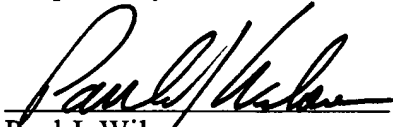
Claim 11 has similar recitations as claim 1. Applicants believe that claim 1 is allowable over the combination of Berry et al. and Flinchem et al. for the same reasons as claim 1, namely the lack of disclosure with respect to key list inheritance between child graphical elements and parent graphical elements. For the sake of brevity, Applicants incorporate by reference the claim 1 arguments concerning the “all limitations” and motivation prongs of a *prima facie* case of obviousness as applying to claim 11 as well. Applicants further believe that claim 13 and new claim 16 are allowable as well, at least by virtue of their dependency from claim 11.

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In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

  
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